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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,246

Applicant(s)

DAUGHERTY ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/15/05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 17, 21, 25-27 include language that the user's input differs depending on the selection made. The claims only require a single instance of receiving user input and it is not clear how a single step of receiving can include information which "differs." Applicant appears to be hinting at the desired types of user submitted content and/or format, however the content/format of the submission is entirely up to the user and cannot be determined or defined by these claims which are drafted from the perspective of the server. Examiner is treating these claims as requiring only the *mere capability* for a user to submit different content and/or formatted user information. A simple text input box would meet this requirement as a user would be capable of submitting a wide variety of differing information through such an input element.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (US6138155) in view of Marsh et al (US5848397). Davis et al teaches serving targeted third party advertisements on webpages, the ads including banners which allow the user to interact with them by way of pulldown menus, clickable buttons, hotspots, text boxes, or any number of input mechanisms [14:1-20]. Such interactions result in the presentation of information to the user. While the delivery/display/output of the requested sounds, videos, text, etc. can be taken to be fulfilled via one or more "associated information delivery processes" (such as delivery to the user's speakers and delivery to the user's screen), Davis et al does not teach fulfillment through email or telephone responses. Marsh et al teaches to provide a "specified portion" of an interactive ad banner as user-selectable in order to request more information. Further, Marsh et al teaches that the user may interact with the banner in order to forward requests for information to the email of the banner-associated vendor. Although the user's clicking that results in information displayed to the user's screen can be taken to be a first delivery process and information delivered to a user responsive to the email request can be taken to be a second delivery process, it would have been obvious to one of ordinary skill at the time of the invention to have included such a "please contact

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me with more information" feature with that of Davis et al so that the vendor can send promotional/informational materials by email to the requestor. It would have been obvious to one of ordinary skill at the time of the invention to have provided multiple GUI interaction options on the banner ad, such as "learn more via telephone" and "learn more via postal mail" in addition to the "learn more via email" option, so as to provide several convenient options for delivery of information through well known communication channels. Emails sent to the user are personalized at least as far as they are personally addressed to the requestor of information. When the user interacts with the specified portion of the banner, this is taken to provide an indication of option selection. Davis et al teaches that personal information about the user is determined and employed to target ads by way of profiles and cookies. It would have been obvious to one of ordinary skill at the time of the invention to have provided a message stating that "your email has been sent to us" or "we will be emailing you the requested info soon" as a courtesy to inform the user that their request for more information has been properly submitted. Completing the steps needed to initiate the email communications is taken as inherent consent for such communications.

Response to Arguments

5. Applicant's arguments filed 6/15/05 have been fully considered but they are not persuasive. Applicant again argues that Marsh et al teaches only a single delivery option, while the claims require plural delivery options. First, not all claims require plural delivery options. For example claim 1 requires plural options, each being associated

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with a delivery process. However they could all be associated with the same delivery process. Nonetheless, Marsh et al's teaching for requesting information by email would motivate one of ordinary skill to offer other well known delivery options, such as by telephone, postal mail, FAX, etc., in order to offer a variety of convenient information channels. Both Davis et al and Marsh et al teach the presence of plural interactive elements on a banner which would have been obvious methods to enable the user to interact and request information via particular delivery methods.

Applicant argues that Davis does not teach plural delivery processes. As stated above, Davis in fact could be taken to provide a first delivery process for information to a user's speakers (audio) and a second delivery process for information to a user's screen (text). Applicant also argues that Marsh et al does not teach plural delivery processes. The user's clicking that results in information displayed to the user's screen can be taken to be a first delivery process and information delivered to a user responsive to the email request can be taken to be a second delivery process.

Most importantly however, applicant has not made any argument regarding the 103 rejection set forth by the examiner that it would have been obvious to have provided an interactive ad with multiple selection options for requesting information by different delivery processes such as by telephone, postal mail and email for example.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc